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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/307,633	05/07/99	NIEHOFF	K L-F/104H

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QM32/0830

EXAMINER

MAYNARD, J

ART UNIT	PAPER NUMBER
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3763

DATE MAILED:

08/30/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/307,633

Applicant(s)

Niehoff

Examiner

Jennifer Maynard

Group Art Unit

3763

☐ Responsive to communication(s) filed on \_\_\_\_\_

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 22-31 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 22-31 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)


☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

  
GLENN K. DAWSON  
PRIMARY EXAMINER

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Response to Arguments***

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22, 24, 26, 28 and 30 recite the limitation “automatically detectable physical indicia” in line 5. It is unclear what the applicant intends to claim by the terminology “automatically detectable”, the meaning is unclear in view of the specification, additionally the Examiner can not distinguish what claimed structure would be detecting the physical indicia in the absence of any means of detection. Therefore the scope of the claim is indiscernable, clarification is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Sahi et al.-'547.

Sahi et al. disclose a hypodermic syringe (10) comprising a needle assembly (12) attached to a plunger-type syringe (18). The plunger-type syringe comprises a barrel member (20) which is generally hollow and terminates in a nozzle (22) of tapered configuration. A sealing plunger (24) is mounted for sliding, reciprocal movement within main bore (20a) of the barrel member. Indicia I may be applied to the barrel member as illustrated in Figure 1 to indicate the volume of liquid contained within the main bore.

Claims 22-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Reilly et al.-'858.

Reilly et al. disclose a front-loading medical injector and syringe (22) comprising an elongated main tubular body or barrel (32), a coaxial discharge injection section (34), a plunger (38) slidably positioned within the tubular body and connectable to an actuating mechanism (40). The syringe may also include a mechanism which provides a visual indication of whether the syringe still includes injection liquid, may have an injector nozzle of reduced diameter surrounded by a screw-threaded cylindrical attachment portion at its injection end, and may be provided with reinforcing ribs which are longitudinally spaced so as to also function as volumetric gradations. The device is also disclosed as capable of administering substances via pre-filled syringes.

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### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 22-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-3 of U.S. Patent No. 5,928,197. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims recite structural elements previously disclosed in the narrower claim language of the above listed patent.

Claims 22-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,662,612. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims recite structural elements previously disclosed in the narrower claim language of the above listed patent.

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*Response to Arguments*

Applicant's arguments filed on June 2, 2000 have been fully considered but they are not persuasive.

The indicia or volumetric gradations on the syringe barrel are considered by the Examiner as automatically detectable once they are in visible proximity to the user.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication should be directed to Jennifer Maynard at telephone number (703) 305-1356. Examiner Maynard can normally be reached at the above number from Mon-Fri. 7:30 A.M. to 5:00 P.M.

If attempts to reach examiner Maynard are unsuccessful, the examiner's supervisor Sharon Kennedy can be reached at 703-305-0154. The fax number for this unit is 703-305-3590.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist at 703-308-0858.

J Maynard *jm*

August 28, 2000

*GD*  
GLENN K. DAWSON  
PRIMARY EXAMINER